

REMARKS

Claim Rejections – 35 U.S.C § 112

Claims 9 was rejected under 35 U.S.C. § 112 ¶ 2 for being indefinite for use of a trademark. The trademark has been removed from the claim, and removal of the rejection is respectfully requested.

Claim Rejections – 35 U.S.C. § 102

Claims 1 and 3-5 were rejected under 35 U.S.C. § 102 (b) as being anticipated by McLean et al. (US 6,510,970) (McLean). Independent claim 1 has been amended to distinctly point out the subject matter of the present invention, as is intended and recited by the claims: an adaptor consisting only of an elongated body as recited in the claims, with the adaptor specifically being directly connected to the dental handpiece. Claims 1, 5 and 9 have also been amended to state that the proximal end for mating directly to the handpiece is a male end. That is, the scope of the invention is for a complete adaptor having an elongated body as claimed., without any extraneous sections or parts. McLean, nor any of the previous art cited by the Examiner, shows such an adaptor.

McLean unquestionably discloses a two-piece adaptor system, wherein both pieces are required for the disclosed coupling adaptor. As shown in Figures 3A and 3B, McLean requires a device having a two-piece construction to join a dental handpiece to a dental tip; the first piece is an air/water tip 20 and the second piece is an adaptor 100. It is incorrect to state that section 100 comprises the adaptor of McLean. McLean states, “FIGS 5A-5B depict another embodiment of a coupling adaptor...adapted to receive only angled distal end 24 of air/water tip 20.” (Col. 6, lines 25-30). Both pieces are required for McLean to be operable. It is not permissible to “pick and choose” from any single reference to the exclusion of other parts necessary for a full appreciation of what the prior art suggests. *W.L. Gore & Assoc., Inc.*, 721 F.2d 1450 (Fed. Cir. 1983). Also, “a prior art invention must be considered in its entirety, i.e., as a whole, including portions that would lead away from the claimed invention” MPEP § 2141.02 (citing *Gore*). Thus, since McLean specifically discloses a two-piece adaptor, with both pieces of the adaptor being required for proper use as intended by McLean, it does not disclose an adaptor that consists of an elongated body as claimed.

It should also be noted that section 100 of McLean does not meet the claim limitation of a male press-fitting end. The end 112 of McLean is not designed to be fit directly with the handpiece,

as is evidence by the requirement of air/water tip 20. Likewise, the end 112 is not a male end that would be secured directly to the adaptor, and any suggestion that the end 112 would be modified to be connected to a handpiece as claimed comes directly from the Applicant's own disclosure. "The prior art must provide a motivation or reason for the worker in the art, without the benefit of appellant's specification, to make the necessary changes in the reference device." See MPEP § 2144.04. Ex parte Chicago Rawhide Mfg. Co., 223 USPQ 351, 353 (Bd. Pat. App. & Inter. 1984). McLean does not show the claimed adaptor, and the only motivation to form the claimed adaptor comes from the Applicant's own disclosure. Removal of the rejection is respectfully requested.

Claim Rejections – 35 U.S.C. § 103(a)

Claim 9 was rejected under 35 U.S.C. §103(a) under McLean. As noted above, McLean discloses a two-piece adaptor, an adaptor that does not anticipate the claimed adaptor of claim 9, nor would it be obvious to modify the shortcomings noted above, as such modifications would be counterintuitive to the disclosure and use of McLean. Accordingly, removal of the rejection is respectfully requested.

Conclusion

Claims 1, 3-5 and 9 remain in the application. It is believed that the amendments to the claims overcome the Examiner's rejections, and allowance is respectfully requested.

Respectfully Submitted,

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